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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/711,970 | 10/15/2004 | Peter D. Saunders | 60655.6400 | 5969 |

| 5514 | 7590 | 05/04/2006 |
|---|---|---|

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| EXAMINER |
|---|
| LE, DANH C |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2617 | |

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/711,970 | SAUNDERS, PETER D. |
| | Examiner | Art Unit |
| | DANH C. LE | 2617 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>28 October 2004</u>.

2a)☐ This action is **FINAL**.           2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-13</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-13</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## *Conclusion*

### *Information Disclosure Statement*

1.  The information disclosure statement (IDS) submitted on 10/15/04, 10/28/04,

11/01/04, 3/28/05, 3/30/05 and 4/29/05 have been considered by the examiner and

made of record in the application file.

### *SET I*

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2.  **Claims 1-13 are rejected under 35 U.S.C. 102(a) as being anticipated by**

**Gehrmann (US 20040176071).**

As to claim 1, Gehrmann teaches a method for facilitating remote configuration

of a RF module for RF transaction completion (figure 1, 2 and their descriptions)

comprising:

providing a RF module configured for use with a mobile device including a mobile

device microprocessor, the RF module configured to be in physical and logical

communication with the mobile device microprocessor;

facilitating mutual authentication between a personalization unit and the RF

module; and

providing the personalization file to the RF module via the mobile device

microprocessor to enable the RF module for RF transaction processing, the

personalization file being provided by a RF module account issuer system

personalization unit.

As to claim 2, Gehrmann teaches a method of claim 1, comprising providing the

RF module with an authentication key prior to providing the RF module to the mobile

device (figure 3, 4 and their descriptions).

As to claim 3, Gehrmann teaches a method of claim 1, comprising

communicating with the RF module via a mobile device account issuer to facilitate

mutual authentication between the personalization system and the RF module (figure 1,

2 and their descriptions).

As to claim 4, Gehrmann teaches a method of claim 1, comprising

communicating with the RF module to supply the personalization file via the mobile

device subsequent to communicating with the mobile device account issuer, wherein

communication with the mobile device account issuer is established prior to

communicating with the RF module (figure 1, 2 and their descriptions).

As to claim 5, Gehrmann teaches a method of claim 4, comprising verifying that

the RF module is valid for personalization by the personalization unit (figure 1, 2 and

their descriptions).

As to claim 6, Gehrmann teaches a method of claim 1, comprising providing the

personalization file to the RF module via a mobile device account provider (figure 1, 2

and their descriptions).

As to claim 7, Gehrmann teaches a method of claim 1, comprising providing the personalization file to the RF module through direct communication .

As to claim 8, Gehrmann teaches a method of claim 1, comprising providing the personalization file to the RF module via a mobile device universal bus (USB), the mobile device USB being in communication with the personalization unit and with the mobile device microprocessor (figure 3 and its description).

As to claim 9, the claim is computer software claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 10, the claim is a system claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 11, the claim is a system claim of claim 4; therefore, the claim is interpreted and rejected as set forth as claim 4.

As to claim 12, the claim is a system claim of claim 8; therefore, the claim is interpreted and rejected as set forth as claim 8.

As to claim 13, the claim is a system claim of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

## SET II

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**3.** <u>**Claims 1, 9, 10 are rejected under 35 U.S.C. 102(a) as being anticipated by**</u>

<u>**Yaqub (US 20040180657).**</u>

As to claim 1, Yaqub teaches a method for facilitating remote configuration of a

RF module for RF transaction completion (figure 1, 2 and their descriptions) comprising:

providing a RF module configured for use with a mobile device including a mobile

device microprocessor, the RF module configured to be in physical and logical

communication with the mobile device microprocessor;

facilitating mutual authentication between a personalization unit and the RF

module; and

providing the personalization file to the RF module via the mobile device

microprocessor to enable the RF module for RF transaction processing, the

personalization file being provided by a RF module account issuer system

personalization unit.

As to claim 9, the claim is computer software claim of claim 1; therefore, the

claim is interpreted and rejected as set forth as claim 1.

As to claim 10, the claim is a system claim of claim 1; therefore, the claim is

interpreted and rejected as set forth as claim 1.

*SET III*

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed
publication in this or a foreign country, before the invention thereof by the applicant for a patent.

## 4. Claims 1-13 are rejected under 35 U.S.C. 102(a) as being anticipated by

## Rosenberg (US 2004/0235450)

As to claim 1, Rosenberg teaches a method for facilitating remote configuration

of a RF module for RF transaction completion (figure 1-5 and their descriptions)

comprising:

providing a RF module configured for use with a mobile device including a mobile

device microprocessor, the RF module configured to be in physical and logical

communication with the mobile device microprocessor;

facilitating mutual authentication between a personalization unit and the RF

module; and

providing the personalization file to the RF module via the mobile device

microprocessor to enable the RF module for RF transaction processing, the

personalization file being provided by a RF module account issuer system

personalization unit.

As to claim 2, Rosenberg teaches a method of claim 1, comprising providing the

RF module with an authentication key prior to providing the RF module to the mobile

device (figure 1-5 and their descriptions).

As to claim 3, Rosenberg teaches a method of claim 1, comprising

communicating with the RF module via a mobile device account issuer to facilitate

mutual authentication between the personalization system and the RF module (figure 1-

5 and their descriptions).

As to claim 4, Rosenberg teaches a method of claim 1, comprising communicating with the RF module to supply the personalization file via the mobile device subsequent to communicating with the mobile device account issuer, wherein communication with the mobile device account issuer is established prior to communicating with the RF module (figure 1-5 and their descriptions).

As to claim 5, Rosenberg teaches a method of claim 4, comprising verifying that the RF module is valid for personalization by the personalization unit (figure 1-5 and their descriptions).

As to claim 6, Rosenberg teaches a method of claim 1, comprising providing the personalization file to the RF module via a mobile device account provider (figure 1-5 and their descriptions).

As to claim 7, Rosenberg teaches a method of claim 1, comprising providing the personalization file to the RF module through direct communication .

As to claim 8, Rosenberg teaches a method of claim 1, comprising providing the personalization file to the RF module via a mobile device universal bus (USB), the mobile device USB being in communication with the personalization unit and with the mobile device microprocessor (810).

As to claim 9, the claim is computer software claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 10, the claim is a system claim of claim 1; therefore, the claim is interpreted and rejected as set forth as claim 1.

As to claim 11, the claim is a system claim of claim 4; therefore, the claim is interpreted and rejected as set forth as claim 4.

As to claim 12, the claim is a system claim of claim 8; therefore, the claim is interpreted and rejected as set forth as claim 8.

As to claim 13, the claim is a system claim of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Silverter (US 2005/0221853) teaches user authentication using a mobile phone SIM card.
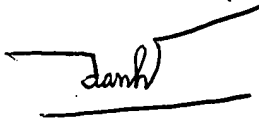
B. Rodgriguez et al (US 2005/0113137) teaches wireless rechargeable money card.

C. Goldthwaite et al (US 2004/0127256) teaches mobile devices equipped with a contactless smart card reader/writer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C. LE whose telephone number is 571-272-7868. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

April 25, 2006.

DANH CONG LE
PRIMARY EXAMINER